

AppIn No. 09/921,856
Amdt. dated Jan 28, 2004
Reply to Office Action of Oct 28, 2003
Docket No. BOC9-2000-0082 (217)

REMARKS/ARGUMENTS

These remarks are made in response to the Office Action of October 28, 2003 (Office Action). As this response is timely filed within the 3-month shortened statutory period, no fee is believed due.

In paragraph 4 of the Office Action, claims 1-17 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication No. 2002/0023230 to Bolnick, *et al.* (Bolnick) in view of U.S. Publication No. 2002/0016857 to Harari (Harari).

Claims 1, 4, 6, 7, 12, 15, and 17 have been amended to clarify that the contact lists that are compared correspond to different users.

Prior to addressing the rejections on the art, a brief review of the Applicants' invention is appropriate. The Applicants have invented a method, system, and apparatus for identifying common contacts through which people can establish relationships. In one embodiment, contact lists of different users can be compared to determine whether the users associated with the contact lists have any acquaintances or contacts in common with one another.

In another embodiment, mutual contacts of different users can be identified despite the fact that such mutual contacts are known through several "degrees of separation". That is, the present invention can analyze at least two (original) contact lists, where each contact list corresponds to a different user. The contact lists of contacts specified in one (or more) of the "original" contact lists can be retrieved and then compared with one (or more) of the "original" contact lists. In this manner, contact lists can be processed to determine whether two parties are connected through, or know, "friends of friends".

Regarding claims 1 and 12, the Examiner asserts that Bolnick teaches the following steps:

- first retrieving a plurality of contacts from an exposed, remotely accessible contact list;
- first comparing said first retrieved contacts to stored contacts in a locally accessible contact list;

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- second retrieving a plurality of contacts from an exposed, remotely accessible contact list associated with one of said first retrieved contacts; and
- second comparing said second retrieved contacts to said locally stored contacts;

The Applicants respectfully disagree. Bolnick fails to teach or suggest the step of first comparing the first retrieved contacts to stored contacts in a locally accessible contact list. The Office Action cites paragraphs 162-167 of the Bolnick specification and states that the term "comparator" reads on the phrase "out-of-date".

Paragraph 167, from which the phrase "out-of-date" was quoted, states in relevant part that "[t]he days of out-of-date contact information are history for site users 102 since a change in a shared phone listing can be seen by all members who are linked to that phone listing." The quoted passage merely makes an assertion that one need not worry about out-of-date contacts, but provides absolutely no teaching as to how contacts are kept up-to-date. In any case, the Applicants' invention is not concerned with keeping contacts up to date. Instead, the Applicants' invention determines whether two users have any contacts in common through a comparison of each user's contacts.

From the cited reference, it appears that users can share contact information with other parties. If so, Bolnick does not teach any sort of comparing step, i.e. that contacts from a remotely, accessible contact list can be compared with stored contacts in a locally accessible contact list. Rather, Bolnick only provides users with access to one's phone list, for example via a Website. The Applicants' invention, as claimed, requires the comparison of one set of contacts corresponding to a user with another set of contacts corresponding to a different user. The cited portion of Bolnick does not teach or suggest that one contact list can be compared with another contact list, let alone contact lists corresponding to different users.

Bolnick also does not teach or suggest the steps of second retrieving a plurality of contacts from an exposed, remotely accessible contact list associated with one of the first retrieved contacts and second comparing the second retrieved contacts to the

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locally stored contacts. In illustration, paragraphs 167-171, which were cited in the Office Action, teach that a user may have an "associations" section which includes information regarding businesses and organizations with whom the user associates. Paragraphs 68-70 teach that access to this information can be shared through a variety of different mechanisms. While Bolnick teaches that association information can be included for users of the Web site, Bolnick does not determine such information in the manner recited in the Applicants' claims. Moreover, as noted, Bolnick fails to teach or suggest a comparing step.

As claimed, the Applicants' invention compares first retrieved contacts with locally stored contacts. Additional contacts are retrieved from an exposed, remotely accessible contact list associated with one of the first retrieved contacts. Thus, after retrieving a first set of contacts from an exposed, remotely accessible contact list, other contacts are retrieved from another exposed, remotely accessible contact list that corresponds to a contact in the first set of retrieved contacts. Bolnick does not teach or suggest such a step.

The above-noted features allow the Applicants' invention to identify contacts common between two users, for example friends of friends, in the case where the users do not know one another. Bolnick is not configured to perform such a task.

The Office Action does concede that Bolnick fails to disclose "first identifying common contacts among said first compared contacts; second identifying common contacts among said second compared contacts; and storing said identified common contacts in a list of common contacts." It is asserted, however, that Harari discloses such features and that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bolnick with the teachings of Harari.

Harari, however, fails to cure the deficiencies of Bolnick. Harari discloses an address server system which provides for automatic updates of contact information. Harari, like Bolnick, fails to teach or suggest that contact lists of different users can be compared to identify common contacts.

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Further, Harari does not identify common contacts between the second compared contacts, i.e. the locally stored contacts and the contacts retrieved from the contact list associated with the first retrieved contacts. As noted, the Applicants' invention can identify "friends of friends". That is, based on a first set of retrieved contacts, contact lists for persons or organizations specified in the first set of retrieved contacts can be retrieved and compared with the locally accessible contact list to identify common contacts. Not only does Harari fail to teach or suggest comparing steps as recited in claims 1 and 12, but Harari also is incapable of operating on this second layer to identify "friends of friends".

Paragraph 33 of Harari, which was cited by the Office Action, teaches only that the server can determine whether one version of contact information is newer than another version of contact information for a same user. Paragraph 43 of Harari, also cited by the Office Action, teaches that the most recent contact information for a user can be obtained. Again, the Applicants' invention does not update contact lists, but rather compares various contact lists to identify whether contacts are held in common between two users.


Regarding claims 4, 6, 7, 15, and 17, as noted above, neither Bolnick, Harari, nor any combination thereof teaches or suggests that contacts corresponding to different users can be compared with one another to identify contacts common between the two users. As neither Bolnick, Harari, nor any combination thereof teaches or suggests the Applicants' invention as claimed, withdrawal of the 35 U.S.C. § 103(a) rejection with respect to claims 1-17 is respectfully requested.

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The Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. The Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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Gregory A. Nelson, Registration No. 30,577
Kevin T. Cuenot, Registration No. 46,283
Brian K. Buchheit, Registration No. 52,667
AKERMAN SENTERFITT
Post Office Box 3188
West Palm Beach, FL 33402-3188
Telephone: (561) 653-5000